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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,479	08/01/2003	Yuri Leontiev	INTU-990057	3014
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EXAMINER MURDOUGH, JOSHUA A				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/632,479

Applicant(s)

LEONTIEV ET AL.

Examiner

JOSHUA MURDOUGH

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-47 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 38-47 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Acknowledgement

1. Claims 38-47 are pending and have been examined.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 38-41, 46, and 47 are rejected under 35 U.S.C. §103(a) as being unpatentable over Rabin (US 6,697,948) in view of Tinney (Organize Your Finances in a Weekend with Quicken® 2000).

4. As to claim 38, Rabin shows:

- a. A computer implemented client method for dynamically managing a user software license, the method comprising:
- b. receiving an action from the user **213** to access a software program (software(SW)) (Figure 12, step 370);
- c. responsive to receiving the action from the user, sending a request (call up) to a server (guardian center) to access the software program (Id.), the request including license verification information concerning the user (tag) (Figure 12, step 372);

- d. receiving current software license information concerning the user from the server (Figure 12, step 374); and
 - e. storing (an update stores new information) received current software license information concerning the user (Figure 12, step 375).
5. Rabin does not expressly show that the validation is performed on a per feature basis.
6. However, Tinney shows a list of features available to the user depending on the license possessed (Pages 327-329). As the features the user is permitted to use depend on the license, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Rabin to verify the license when the user attempts to use a feature that they may or may not have a license for in order to limit the user to only the features they are licensed for and thus, have paid for.
7. As to claim 39, Rabin further shows:
- f. performing at least one step (Figure 12, step 376) from a group of steps comprising:
 - g. displaying a message to the user indicating that the user is not licensed to run the software program (Column 54, lines 14-17);
 - h. providing the user with an opportunity to purchase a license to run the software program (Column 59, lines 38-57);
 - i. allowing the user to run the software program without a license for a limited time only (Column 5, lines 36-53);

- j. allowing the user to run the software program without a license a limited number of times only (Id.); and
 - k. terminating the software program, such that the user cannot run the software program (Column 54, lines 14-19).
- 8. As to claim 40, Rabin further shows:

the received current software license information concerning the user comprises modified license information concerning the user (the tag is modified in Figures 13A and 13B, therefore, the next time the tag is sent it would be modified).
- 9. As to claim 41, Rabin further shows:

l. the modified license information concerning the user comprises a user software license from a group of user software licenses comprising:
 - m. an activated user software license (installed, Figure 6);
 - n. a deactivated user software license (gc_disabled, Id.);
 - o. an extended user software license (continued, Id.);
 - p. a restricted user software license (policy, Columns 55-56, lines 57-10);
- 10. As to claim 46, Rabin shows:

q. A computer readable medium **200** containing instructions that, when executed, cause the computer system to perform desired actions for dynamically managing a user software license, wherein the instructions comprise:

- r. program code for receiving an action from the user 213 to access a software program (Figure 12, step 370);
 - s. program code for, responsive to receiving the action from the user, sending a request (call up) to a server (guardian center) to access the software program (Id.), the request including identification information concerning the user, and license verification information concerning the user (tag) (Figure 12, step 372);
 - t. program code for receiving current software license information concerning the user from the server (Figure 12, step 374);
 - u. program code for storing (an update stores new information) received current software license information concerning the user (Figure 12, step 375); and
11. Rabin does not expressly show that the validation is performed on a per feature basis.
12. However, Tinney shows a list of features available to the user depending on the license possessed (Pages 327-329). As the features the user is permitted to use depend on the license, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Rabin to verify the license when the user attempts to use a feature that they may or may not have a license for in order to limit the user to only the features they are licensed for and thus, have paid for.
13. As to claim 47, Rabin shows:
- v. A computer system for dynamically managing a user software license, the computer system comprising:

- w. a mechanism for receiving an action from the user 213 to access a software program (software(SW)) (Figure 12, step 370);
 - x. a mechanism for, responsive to receiving the action from the user, sending a request (call up) to a server (guardian center) to access the feature of the software program (Id.), the request including identification information concerning the user (fingerprint), and license verification information concerning the user (tag) (Figure 12, step 372);
 - y. a mechanism for receiving current software license information concerning the user from the server (Figure 12, step 374); and
 - z. a mechanism for storing received current software license information concerning the user (Figure 12, step 375).
14. Rabin does not expressly show that the validation is performed on a per feature basis.
15. However, Tinney shows a list of features available to the user depending on the license possessed (Pages 327-329). As the features the user is permitted to use depend on the license, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Rabin to verify the license when the user attempts to use a feature that they may or may not have a license for in order to limit the user to only the features they are licensed for and thus, have paid for.
16. Claims 42-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rabin and Tinney as applied to claim 38 above, and further in view of another embodiment of Rabin.

17. As to claims 42-44, the Rabin/Tiney combination teaches as disclosed above, but does not expressly teach:

- aa. creating a current hardware configuration identifier of the computer associated with the user; and
- bb. comparing the received hardware configuration identifier to the current hardware configuration identifier.

18. However, Rabin teaches, outside of the embodiment used above, the use of a hardware identifier, specifically a processor identifier, compared with the stored value to enable, or prevent the use of software (Columns 1-2, lines 57-2). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have further modified the teachings of the first embodiment of Rabin to use a processor identifier in the authentication of the user device because hardware identifiers are more difficult to alter.

19. As to claim 45, Rabin further shows:

- cc. performing at least one step (Figure 12, step 376) from a group of steps comprising:
- dd. displaying a message to the user indicating that the user is not licensed to run the software program (Column 54, lines 14-17);
- ee. providing the user with an opportunity to purchase a license to run the software program (Column 59, lines 38-57);
- ff. allowing the user to run the software program without a license for a limited time only (Id.); and

- gg. allowing the user to run the software program without a license a limited number of times only (Column 54, lines 14-19).

Claim Interpretation

20. As discussed in paragraphs 27-29 of the previous action, the Examiner's position is that Applicants' did not intend to invoke 35 U.S.C. 112 6th paragraph with their use of "means for" in claim 47. As suggested in paragraph 27, Applicants have removed "means for" from this claim. Accordingly, the Examiner has not interpreted this claim as prescribed by the above noted section.

Double Patenting

21. Claims 42-46 of this application conflict with claims 1-3, 29-31, 43-45, and 55-63 of Application No. 10/684955. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

Response to Arguments

22. Applicant's arguments filed 17 October 2008 have been fully considered but they are not persuasive.

23. Applicants argue:

24. "Tinney does not disclose making features available to a user depending on the license possessed on a per feature basis" (Remarks, Page 8, Paragraph 1).

25. Examiner's response:

26. It appears that Applicants intend to claim a method where each feature may be licensed individually. However, the present claims do not make this distinction. If this distinction is added to the claims it would likely overcome the present rejections.

27. Applicants argue:

28. "[C]laims 1-3, 29-31, 43-45, and 55-63 of Application No. 10/684,955 are directed to a server method for dynamically managing a user software license, where the server method receives a request from a client for access to at least one feature of a software program, and returns to the client a corresponding software license in response to the request. In contrast, claims 38- 47 of the present invention are directed to a client method for dynamically managing a user software license, where the client method sends a request to a server for access to a feature from one or more features of a software program in response to an action from a user to access the feature, and receives a corresponding software license from the server" (Remarks, Page 9, Paragraph 3).

29. Examiner's response:

30. Essentially, Applicants argue that the inventions of the two applications are patentably distinct because of the computer executing the method. It is well known in the art that computers are multipurpose machines. Most "client" computers (such as a PC) come equipped with software to enable them to operate as a server as part of the operating system. If the computer does not have the software as part of the operating system, there are numerous easily obtainable software packages that can be installed (sambar server, apache, etc.). Therefore, the difference between a client and a server is the current role the computer is fulfilling and the altering of settings or installation of a software package. These differences would be obvious to one of ordinary skill in the art. These would be the changes made in configuring the server that is required in both inventions. Therefore, one of ordinary skill would have to know how to perform the modification. Thus, the Double Patenting rejection has been maintained.

Conclusion

31. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Mirabella (US 2004/0167859) shows client/server feature licensing.

32. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

33. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

34. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to JOSHUA MURDOUGH whose telephone number is (571)270-3270. The Examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m.

35. If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

36. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

J. M.
Examiner, Art Unit 3621

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621